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EXAMINER

IWARE, OLUSEYE

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3687

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/694,311

Applicant(s)

DAVIS, TOMMY L.

Examiner

OLUSEYE IWARERE

Art Unit

3687

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This communication is a Final Rejection Office Action on the merits. Correspondence sent January 29, 2008 has been received. Claims 1 – 22, as originally amended on January 29, 2008 have been entered, are currently pending and have been considered below.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1), MPEP § 608.01(o), and MPEP §2181. Correction of the following is required:

- a. The “means for receiving owner registration data and item data” as recited in claim 15.
- b. The “means for determining whether the item matches stored item data” as recited in claim 15.
- c. The “means for storing the owner registration data as an authenticated owner registration data” as recited in claim 15.
- d. The “means for determining whether the item data matches stored item data” as recited in claim 16.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- e. The "means for receiving owner registration data and item data" as recited in claim 15.
- f. The "means for determining whether the item matches stored item data" as recited in claim 15.
- g. The "means for storing the owner registration data as an authenticated owner registration data" as recited in claim 15.
- h. The "means for determining whether the item data matches stored item data" as recited in claim 16.
- i. In Claim 15, the specification does not clearly link the corresponding structure to:
 - i. The "means for receiving owner registration data and item data."
 - ii. The "means for determinant whether the item data matches stored item data."
 - iii. The "means for storing the owner registration data as authenticated owner registration data."
- j. In Claim 16, the specification does not clearly link the corresponding structure to:

- iv. The "means for determining whether the item data matches stored item data."

"Failure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2." *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. As per claims 15 and 16, the system contains software (data) structures not claimed as embodied in computer-readable media and therefore are descriptive material *per se* and are not statutory because they are not capable of causing function change in a computer. See *In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1 and 4 – 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowers et al. (5,963,134).**

As per claim 1, Bowers discloses, a system for tracking an authenticated item comprising:

an authentication device affixed to the item ([abstract]; uses RFID tags attached to each article);

an item registration system receiving authentication device data from the authentication device and associated item data and storing the authentication device data and the associated item data (col. 2, lines 16 – 19; via the identification information stored in the integrated circuit of an interrogated tag; and a database for receiving the interrogator output signals); and

an owner registration system receiving owner registration data after a buyer has acquired the item (col. 3, lines 30 – 34; via the database receives the patron identification information and the article identification information for each of the articles to be borrowed. The patron is construed as the buyer); and

a buyer verification system receiving the authentication device data, the associated item data and the owner registration data and storing buyer verified data if the associated item data correlates to the owner registration data (col. 11, lines 17 – 22; the patron may directly identify himself or herself to the system 50 by entering an ID

and/or password into the computer terminal 52. The patron ID data is received by the computer terminal 52, which communicates with a database of patrons stored in the computer 48 to verify that the patron is authorized to check out articles 22).

As per claim 4, Bowers discloses, wherein the item registration system further comprises:

an item check-out system receiving item check-out data for the item when it is removed from inventory for use (col. 2, lines 18 – 21; via the database including inventory data for articles monitored by the system including checkout status data);

an item check-in system receiving item check-in data for the item when it is returned to inventory from use (col. 4, lines 27 – 29; via the inventory database receives the interrogator output signals and updates the checkout status data of the article being returned therewith); and

an event verification system providing event verification data associated with the item while it was in use (col. 20, lines 58 – 62; via the first interrogator receiving a response signal containing the stored article identification information for the article to be removed; a processor in communication with the first interrogator and the database).

As per claim 5, Bowers discloses, wherein the purchaser verification system further comprises a chain of custody system receiving purchase location data and determining whether chain of custody data exists for the item that ends at the purchase location (col. 1, lines 30 – 32; The database receives the patron identification

information and the article identification information for each of the articles to be borrowed) (col. 4, lines 11 – 15; and updating the inventory database with the circulation status of the article to be removed) (FIG. 8 is a sample historical usage report 136).

As per claim 6, Bowers discloses, further comprising an alert system generating an alert to an operator if the associated item data does not correlate to the owner registration data (col. 5, lines 43 – 45; wherein the zone interrogator activates an alarm in response to the detection of the removal of an article from the predefined area).

As per claim 7, Bowers discloses, further comprising an item transfer system receiving purchaser data from an owner and requesting confirmation from a purchaser based on the purchaser data (col. 4, lines 52 - 57; via a processor in communication with the first interrogator and the database, the processor receiving the patron identification information and the article identification information for the article to be removed from the first interrogator, and updating the inventory database with the circulation status of the article to be removed).

As per claim 8, Bowers discloses, further comprising a personage verification system receiving personage data and providing item data that corresponds to the personage data (col. 4, lines 43 – 44; a patron identification device for identifying a patron to the system).

As per claim 9, Bowers discloses, a method for tracking an authenticated item comprising:

affixing an authentication device to the item (col. 2, lines 1 – 2; Each of the articles has an RFID tag attached thereto);

storing authentication device data and item description data (col. 2, lines 4 – 5; the tag also includes an integrated circuit connected to the antenna for storing article identification information);

receiving owner registration data (col. 3, lines 24 – 26; the interrogator receives a response signal containing the stored article identification information for each of the articles to be borrowed and patron identification information from the ID card); and

generating confirmation data if the owner registration data and the item description data are correlated to the authentication device data (col. 17, lines 31 – 34; if the patron borrows an item from a multi-media lab, the patron's RFID card and the article's jacket or holder (which is tagged) would be read and associated with each other).

As per claim 10, Bowers discloses, further comprising generating alert data if the owner registration data and the item description data are not correlated to the authentication device data (col. 12, lines 10 – 12; If an article 22 is not properly checked out, a visible and/or audio alarm is triggered to alert the patron and library employees to the problem).

As per claim 11, Bowers discloses, wherein affixing the authentication device to the item comprises affixing a radio frequency identification tag to the item (col. 2, lines 1 – 2; Each of the articles has an RFID tag attached thereto).

As per claim 12, Bowers discloses, wherein generating confirmation data if the owner registration data and the item description data are correlated to the authentication device data comprises determining whether item description data provided with the owner registration data matches item description data associated with the authentication device data (col. 20, lines 38 – 40; the processor receiving an output signal from the exit interrogator including the identification information of the response signal, wherein the processor compares the received identification information with the information stored in the database to determine whether the article is recorded therein as checked out).

As per claim 13, Bowers discloses, further comprising:
receiving personage data associated with the item (col. 4, lines 43 – 44; a patron identification device for identifying a patron to the system); and
generating a report that includes the item data based on the personage data.
(col. 4, lines 10 – 15; the processor receiving the patron identification information and the article identification information for the article to be removed from the first interrogator, and updating the inventory database with the circulation status of the article to be removed).

As per claim 14, Bowers discloses, further comprising:

receiving item transfer data from a current owner (col. 11, lines 28 – 32; via he patron manipulates either the article 22 to be checked out and/or the fixed interrogator 43 or scanner 42 so as to interrogate the tag 54 associated with the article 22 and read the data returned by the tag 54);

receiving transfer confirmation data from a prospective owner (col. 1, lines 36 – 39; via the tag serial number is sent directly, or through the computer terminal 52, to the computer 48 which locates the appropriate record for the article 22 in its database 66) (col. 12, lines 3 – 6; via to ensure that only articles 22 which were properly checked out are removed from the library 10, the pair of smart pedestals 36 (which incorporates the elements of the interrogator 100 of FIG. 3 therein) interrogates the articles 22 as they pass through a zone in which a patron or employee must pass through to exit the library 10.); and

storing the prospective owner data as the owner registration data after receiving the transfer confirmation data. (col. 11, lines 40 – 42; via the database 66 is then updated to show that the article 22 has been checked out to the patron currently using the station 50).

As per claim 15, Bowers discloses, a system for authenticating an item comprising:

means for receiving owner registration data and item data (col. 11, lines 7 – 12; via when a patron wishes to check out an article 22 from the library collection, the patron identifies himself or herself to the system through a patron identification (ID) device 68. The patron ID device 68 may be a card reader, such as a bar code reader or magnetic stripe reader for reading data from a patron's library card. The patron ID device 68 may also be the same fixed interrogator 43 or RFID scanner 42 used for interrogating articles 22.);

means for determining whether the item data matches stored item data (col. 2, lines 16 – 19; via the identification information stored in the integrated circuit of an interrogated tag; and a database for receiving the interrogator output signals); and

Means for storing the owner registration data as authenticated owner registration data (col. 11, 19 – 27; via the patron ID data is received by the computer terminal 52 which communicates with a database of patrons stored in the computer 48 to verify that the patron is authorized to check out articles 22. If the patron is not in the patron database or if the patron is delinquent, the checkout procedure may be either terminated or the computer terminal may enter a patron registration routine. After the patron is identified and determined to be an authorized user, the checkout process may begin by performing the following steps).

As per claim 16, Bowers discloses, wherein the means for determining whether the item data matches stored item data further comprises an item identification system receiving authentication device data from an authentication device attached to the item

and storing the authentication device data as the item data (col. 2, lines 2 – 8; via each of the articles has an RFID tag attached thereto. Each tag includes an antenna for use in detecting the presence of the article by receiving an interrogation signal and returning a response signal. The tag also includes an integrated circuit connected to the antenna for storing article identification information and for outputting the article identification information with the response signal upon interrogation of the tag).

As per claim 17, Bowers discloses, further comprising an authentication device attached to the item in a manner that allows the authentication device to be read by an authentication device reader and that generates an indication if the authentication device is removed from the item (col. 21, lines 62 – 63; via the system according to claim 13 wherein the tag is a physically non-deactivatable tag).

As per claim 18, Bowers discloses, further comprising an owner flagging system receiving flag data for the item and generating item transfer data (col. 10, lines 35 – 38; via item identification information may also include any part of the bibliographic data, such as title, author, publisher and the like. optionally, the database record may include additional information, such as a predetermined location of a large library system where the article 22 is stored, which is understood as intended to facilitate the borrowing of the articles.)

As per claim 19, Bowers discloses, further comprising a buyer identification system receiving buyer identification data and generating buyer transfer query data (col. 3, lines 30 – 34; via the database receives the patron identification information and the article identification information for each of the articles to be borrowed).

As per claim 20, Bowers discloses, further comprising a buyer verification system receiving buyer transfer confirmation data and changing the owner registration data to the buyer identification data (col. 11, lines 40 – 42; The database 66 is then updated to show that the article 22 has been checked out to the patron currently using the station 50).

As per claim 22, Bowers discloses, further comprising a tracking personalization system receiving item data and associating the item data with a personalization database ([abstract]; via an inventory database tracks all of the tagged articles and maintains circulation status information for each article).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et. al. (5,963,134) in view of Molee et al. (5,380,047).**

As per claim 2, Bowers discloses, wherein the authentication device comprises:
a radio frequency identification tag having a unique identifier ([abstract]; via using RFID tags attached to each article. Each tag has a unique identification or serial number for identifying the individual article).

However, Bowers fails to disclose a metallic tag having a hologram etched upon a surface and a peel-away adhesive layer affixed to the radio frequency identification tag and the metallic tag, wherein a portion of the peel-away adhesive layer remains affixed to the item if the authentication device is removed from the item.

Molee teaches a metallic tag having a hologram etched upon a surface (col. 2, lines 17 – 20; Through the use of a tamper proof hologram, the hologram 14 cannot be removed or copied without at east partially destroying the hologram);

and a peel-away adhesive layer affixed to the radio frequency identification tag and the metallic tag, wherein a portion of the peel-away adhesive layer remains affixed

to the item if the authentication device is removed from the item (col. 2, lines 19 –22; These tamper proof holograms are well known and comprise a hologram on a substrate with an overlying clear film).

From this teaching of Molee, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the authentication device of Bowers to include the hologram and peel-away adhesive layer taught by Molee in order to ensure an article is genuine and prevent the device from being tampered with.

As per claim 3, Bowers teaches, wherein the radio frequency identification tag, such that the radio frequency identification tag remains affixed to the item if the authentication device is removed from the item ([abstract]; via using RFID tags attached to each article. Each tag has a unique identification or serial number for identifying the individual article).

However, Bowers fails to explicitly disclose being affixed to the peel-away adhesive layer and is separate from the metallic tag.

Molee teaches affixed to the peel-away adhesive layer and is separate from the metallic tag (col. 2, lines 19 – 22; These tamper proof holograms are well known and comprise a hologram on a substrate with an overlying clear film).

From this teaching of Molee, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the authentication device of Bowers to include the peel-away adhesive layer, separate from the metallic tag, in order to facilitate check-in/checkout, inventorying, and theft control of articles.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et. al. (5,963,134) in view of Conway (5,732,401).

As per claim 21, Bowers discloses all the elements of the claimed invention, but fails to explicitly disclose, further comprising an item appraisal system receiving item appraisal data and associating the item appraisal data with item data.

Conway teaches, further comprising an item appraisal system receiving item appraisal data and associating the item appraisal data with item data (col. 2, lines 57 – 59; via costs may be tracked on a per-use or per-activity basis, or on a time basis, or both, whichever is the most accurate measure of the costs of personnel and/or equipment).

From this teaching of Conway, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system for tracking authenticated items of Bowers to include the appraisal system of Conway in order to establish profitable pricing.

35 U.S.C. 112 6th Paragraph

6. First, after further review of the specification, it is the Examiner's position that the potential means-plus-function limitations in claims 15 and 16 are *not* the *only* point of novelty. The Examiner begins his § 112 6th paragraph analysis with this presumption.

Means Phrase #1

Invocation

7. It is the Examiner's position that in claim 15, the phrase "means for receiving owner registration data and item data" ("Means Phrase # 1") is an attempt by Applicants to invoke 35 U.S.C. 112 6th paragraph. If Applicants disagree, the Examiner respectfully requests Applicants to either amend the claim to remove all instances of "means for" from the claim, or to explicitly state on the record (and supply arguments in support thereof) why 35 U.S.C. 112 6^a paragraph should not be invoked.

Invocation Step 1:

- a. First, in accordance with the MPEP §2181, the Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th ("Guidelines"), and *AI-Site Corp. v. VSI International Inc.*, 174 F.3d. 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999), Applicant's use of "means for" in claim 16 creates a rebuttable presumption that tends to invoke 35 U.S.C. 112 6th paragraph. If the word "means" appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which § 112 6th paragraph applies, *Id.* Since "means for" is recited in Means Phrase #1, this step is clearly met.

Invocation - Step 2:

- b. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it

is the Examiner's position that Applicants recite a corresponding function to the means--
"for receiving owner registration data and item data"

The Examiner notes that when determining the function recited "[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language." *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Here, the function as found in the Means Phrase # 1 will have its ordinary meaning.

Invocation - Step 3:

c. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

In our case, Means Phrase # 1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, "the focus remains on whether the claim ... recites sufficiently definite structure." *Id.* Furthermore, sufficient structure does not require an exhaustive recitation--only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). Clearly the "means for receiving owner registration data and item data" can not be entirely performed by the little if any recited structure in the claim.

Because of the above, it is the Examiner's position that Means Phrase #1 invokes 35 U.S.C. 112 6th paragraph.

Means Phrase #2

8. It is the Examiner's position that in claim 15, the phrase "means for determining whether the item data matches stored item data" ("Means Phrase # 1") is an attempt by Applicants to invoke 35 U.S.C. 112 6th paragraph.

a. Means for Phrase #2 meets invocation step 1 because "means for" is recited.

b. Means for Phrase #2 meets invocation step 2 because the phrase recites the function of "determining whether the item data matches stored item data." This function will have its ordinary and plain meaning

c. Means for Phrase #2 meets invocation step 3 because the claim does not recite sufficient definite structure for performing the function of "for determining whether the item data matches stored item data"

d. The specification fails to directly disclose what structural elements make up Means Phrase #2. In other words, the corresponding structure is not clearly linked in the written description with the required specificity. For prior art purposes only, the Examiner will presume that the corresponding structure is the hardware, software or a suitable combination of hardware and software.

Means Phrase #3

9. It is the Examiner's position that in claim 15, the phrase "means for storing the owner registration data as authenticated owner registration data" ("Means Phrase # 1") is an attempt by Applicants to invoke 35 U.S.C. 112 6th paragraph.

- a. Means for Phrase #3 meets invocation step 1 because "means for" is recited.
- b. Means for Phrase #3 meets invocation step 2 because the phrase recites the function of "determining storing the owner registration data as authenticated owner registration data." This function will have its ordinary and plain meaning
- c. Means for Phrase #3 meets invocation step 3 because the claim does not recite sufficient definite structure for performing the function of "for storing the owner registration data as authenticated owner registration data"
- d. The specification fails to directly disclose what structural elements make up Means Phrase #2. In other words, the corresponding structure is not clearly linked in the written description with the required specificity. For prior art purposes only, the Examiner will presume that the corresponding structure is the hardware, software or a suitable combination of hardware and software.

Means Phrase #4

10. It is the Examiner's position that in claim 16, the phrase "means for determining whether the item data matches stored item data" ("Means Phrase # 1") is an attempt by Applicants to invoke 35 U.S.C. 112 6th paragraph.

- a. Means for Phrase #4 meets invocation step 1 because "means for" is recited.
- b. Means for Phrase #4 meets invocation step 2 because the phrase recites the function of "for determining whether the item data matches stored item data." This function will have its ordinary and plain meaning
- c. Means for Phrase #4 meets invocation step 3 because the claim does not recite sufficient definite structure for performing the function of "for determining whether the item data matches stored item data"
- d. The specification fails to directly disclose what structural elements make up Means Phrase #2. In other words, the corresponding structure is not clearly linked in the written description with the required specificity. For prior art purposes only, the Examiner will presume that the corresponding structure is the hardware, software or a suitable combination of hardware and software.

Response to Arguments

1. Applicant's arguments filed January 29, 2008 have been fully considered but they are not persuasive.

As per claim 1, Applicant argues "the cited sections of Bowers explicitly discloses that the articles of Bowers are borrowed, not purchased. Thus, under the plain language of the claim terms, Bowers fails to anticipate claim 1."

However, the system disclosed in bowers states in col. 18, lines 12 – 18 "It will be appreciated by those skilled in the art that changes could be made to the embodiments described above without departing from the broad inventive concept thereof. It is understood, therefore, that this invention is not limited to the particular embodiments disclosed, but it is intended to cover modifications within the spirit and scope of the present invention"

Therefore, the construing of a borrower as an owner does not fall out of the scope of the invention. A borrower has temporary possession of an article and although the borrower must return the article, the period of time that the article is in the borrower's possession is construed as temporary ownership, which meets the features of the claimed invention.

Furthermore, applicant argues "the articles of Bowers are borrowed, not purchased." However, Applicant uses the term acquired in the claim. The definition of "acquire" as given by www.dictionary.com is "to come into possession or ownership of; get as one's own. The acquiring in the prior art is the step of borrowing the article from the source which falls under the scope. Therefore, the Examiner respectfully disagrees.

As per claims 4 – 20 and 22, applicant argues "Bowers is simply fails to disclose event verification data associated with the item while it was in use, based on the plain meaning of the claim terms."

However, Fig. 4 depicts event verification data associated with the item while it was in use. Therefore, the Examiner respectfully disagrees.

As per claim 5, Applicant argues "there is simply no chain of custody data disclosed in Bowers. In fact, the terms "chain" and "custody" are not even used in Bowers, and Bowers relates to a library system where there is no purchase being made."

However, Fig. 8 depicts a historical usage report, which encompasses a chain of custody data. Therefore, the Examiner respectfully disagrees.

As per claim 6, Applicant argues "it is clear that that section of Bowers relates to determining whether an item leaves a zone, and fails to disclose generating an alert to an operator if the associated item data does not correlate to the owner registration data."

However, the item has a status of owner registration in the system while it is contained within the zone. When the item is removed without the data being updated as checked out by the patron, the owner registration data does not correlate and the alert is generated.

As per claim 7, Applicant argues "the sections of Bowers relied on by the Examiner fail to disclose this claim, and instead relate to a system for checking books out of a library by a person that is borrowing the book."

The Examiner respectfully disagrees. (See remarks on claim 1).

As per claim 8, Applicant argues "The Examiner asserts that a patron identification device for identifying a patron to the system meets this claim limitation, but under the plain meaning of the claim terms, that assertion is incorrect."

The Examiner respectfully disagrees. (See remarks on claim 1).

As per claim 9, Applicant argues, "the sections of Bowers relied on by the Examiner relate to a library system for allowing borrowers to temporarily obtain a book or similar object on loan, are distinguishable from the claimed invention based on the plain meaning of the claim terms."

The Examiner respectfully disagrees. (See remarks on claim 1).

As per claim 10, Applicant argues, "the sections of Bowers cited by the Examiner merely relate to a system for determining whether an item has left an authorized area, and are distinguishable from the claim based on the plain meaning of the claim terms."

The Examiner respectfully disagrees. (See remarks on claim 6).

As per claim 12, Applicant argues, "The library system of Bowers is distinguishable based on the plain language of the claims."

The Examiner respectfully disagrees. (See remarks on claim 1)

As per claim 13, Applicant argues "the library system of Bowers is distinguishable based on the plain meaning of the claim terms. It is noted that the Examiner construed "personage data" and "owner registration data" to be the same,"

However, the patron identification identifying a patron to the system is construed as the claimed personage data. Therefore, the Examiner respectfully disagrees.

As per claim 14, Applicant argues, "the library system of Bowers is distinguishable based on the plain meaning of the claim terms. It is noted again that implicit constructions adopted by the Examiner result in different and clearly unrelated claim terms having the same meaning".

The Examiner respectfully disagrees. (See remarks on claim 1).

As per claim 15, The figure presented is illegible. (see 112 6th paragraph analysis above).

As per claim 17, Applicant argues "The Examiner cites to a section of Bowers that allegedly discloses that a tag of Bowers is physically non-deactivatable, which is distinguishable from claim 17 based on the plain language of the claim terms"

However, Bowers discloses the interrogator receives the response signals regardless of the orientation of the articles in col. 3, lines 25 – 30; which allows the authentication device to be read by an authentication device reader, and if the authentication device is removed from the item, then it would be physically evident from

Art Unit: 3687

the absence of the device which was initially present. Therefore, the Examiner respectfully disagrees.

As per claim 18, Applicant argues, "the library system of Bowers is distinguishable based on the plain meaning of the claim terms.

The Examiner respectfully disagrees. (See remarks on claim 1).

As per claim 19, Applicant argues, "The library system of Bowers is distinguishable based on the plain meaning of the claim terms, and it is further noted that the constructions implicitly adopted by the Examiner construe different claim terms as having the same meaning."

The Examiner respectfully disagrees. (See remarks on claim 1).

As per claim 20, Applicant argues, "The library system of Bowers is distinguishable based on the plain meaning of the claim terms, and it is further noted that the constructions implicitly adopted by the Examiner construe different claim terms as having the same meaning."

The Examiner respectfully disagrees. (See remarks on claim 1).

As per claim 22, Applicant argues, "The library system of Bowers is distinguishable based on the plain meaning of the claim terms, and it is further noted

that the constructions implicitly adopted by the Examiner construe different claim terms as having the same meaning."

The Examiner respectfully disagrees. (See remarks on claim 1).

As per claim 2, Applicant argues "Molee fails to disclose a peel-away adhesive layer affixed to the radio frequency identification tag and the metallic tag, as alleged by the Examiner. In fact, the terms "RFID," "radio" and "frequency" are not even used in Molee. Furthermore, there is simply no motivation to combine Bowers and Molee - the tags used in the library system of Bowers would need to be hidden, so as to prevent patrons from removing and stealing the books that they are attached to."

However, the RFID is taught by the Bowers reference, and the substrate with an overlying clear film is the teaching of the peel-away adhesive layer.

In addition, The Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* published in the Federal Register, Vol. 72, No. 195, pages 57526-57535 sites motivation to combine references. Therefore, the Examiner respectfully disagrees.

As per claim 3, Applicant argues "Bowers in view of Molee fails to disclose the invention of claim 3, even if they are improperly combined." The Examiner respectfully disagrees.

As per claim 21, Applicant argues "The cited section of Conway is simply a cost-tracking system, and is distinguishable from claim 21 based on the plain meaning of the claim terms."

However, Conway discusses accurately measuring the costs of the personnel and or equipment as a method of appraising. Therefore, the Examiner respectfully disagrees.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **OLUSEYE IWARERE** whose telephone number is (571)270-5112. The examiner can normally be reached on **M-Th**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on (571)272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/
Primary Examiner, Art Unit 3687

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